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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TIMOTHY E. OSTROMEK and ANTONIO V. BACARELLA

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Appeal 2009-010635  
Application 10/699,985  
Technology Center 2600

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Before JOSEPH F. RUGGIERO, ELENI MANTIS MERCADER, and  
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1-6, 8-13, and 15-18. Claims 7 and 14 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed Dec. 9, 2008), the Answer (mailed Feb. 6, 2009), and the Reply Brief (filed Apr. 2, 2009) for the respective details. We have considered in this decision only those arguments Appellants actually raised in the Briefs. Any other arguments which Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### *Appellants' Invention*

Appellants' invention relates to image processing in which first and second optical transforms are performed on received light to yield, respectively, a first optically transformed light and a second optically transformed light. First and second metrics are generated in accordance with the optically transformed light, and the metrics are processed to yield a processed metric. An image transformation of the received light is processed by performing an inverse optical transform on the processed metric. *See generally* Spec. 3:2-19.

Claim 1 further illustrates the invention and reads as follows:

1. A method for processing image information, comprising:  
receiving light comprising image information;  
performing a first optical transform on the light to yield a first optically transformed light;

performing a second optical transform on the light to yield a second optically transformed light;

generating a first metric in accordance with the first optically transformed light;

generating a second metric in accordance with the second optically transformed light;

processing the first metric and the second metric to yield a processed metric;

performing an inverse optical transform on the processed metric to process the image information of the light;

generating an image from the processed metric; and  
displaying the image.

### *The Examiner's Rejections*

The Examiner's Answer cites the following prior art references:

Spight	US 4,462,046	July 24, 1984
Evans	US 5,537,669	July 16, 1996
Clune	US 7,187,810 B2	Mar. 6, 2007 (filed Oct. 18, 2002)

Claims 1, 2, 4-6, 8, 9, 11-13, and 15-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spight in view of Clune.

Claims 3 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spight in view of Clune and Evans.

### PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C.

§ 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). Furthermore,

“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

*KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

## ANALYSIS

### *Claims 1, 2, 4-6, 8, 9, 11-13, and 15-18*

Appellants contend with respect to the obviousness rejection of independent claims 1, 8, and 15-17 that Clune does not overcome the deficiencies of Spight in disclosing the claimed generation of first and second metrics in accordance with optically transformed light as well as the processing of the metrics to yield a processed metric. In particular, Appellants argue (App. Br. 8-9; Reply Br. 4) that even assuming, *arguendo*, that Clune’s Figure 2B-2 elements 262, 276 are user displays which generate metrics as posited by the Examiner (Ans. 4), there is no teaching or suggestion that these metrics are further processed to yield a processed metric as claimed.

In a further related argument, Appellants contend (App. Br. 9; Reply Br. 4-6) that the Examiner has not provided a proper basis for combining Spight with Clune. According to Appellants, the supposed user displays of Clune would be a superfluous addition to Spight requiring optical-to-

electrical and electrical-to-optical conversions with no apparent benefit to justify the necessary additional hardware.

We agree with Appellants. We find that Clune, at best, merely discloses (Fig. 2B-2) that processing blocks 262 and 276 receive the outputs of Fourier transform blocks 260 and 274. There is no indication, as argued by Appellants (Reply Br. 5), that the processing blocks 262 and 276 represent user displays which generate metrics as suggested by the Examiner or that the outputs of such blocks are further processed to yield a processed metric.

Further, we simply find no convincing rationale provided by the Examiner as to why the skilled artisan would look to Clune to improve or solve any problems associated with the image processing system of Spight. We agree with Appellants (App. Br. 9; Reply Br. 4-6) that the Examiner's proffered generalized rationale for the proposed combination of Spight and Clune of providing a display to a user of optically transformed images for misalignment correction validation does not rise to the level of an articulated line of reasoning with a rational underpinning to support the legal conclusion of obviousness. *See KSR*, 550 U.S. at 418. As previously discussed, we agree with Appellants that such a user display would be a pointless addition to Spight requiring unnecessary additional electrical-to-optical conversion hardware with no apparent benefit since the beam splitter 34 of Spight would receive the same input it would have received if Clune's user displays were not introduced.

Given the above discussed deficiencies in the applied prior art, we fail to see how and in what manner the disclosure of Spight might have been modified by Clune to arrive at the features set forth in each of the appealed

independent claims 1, 8, and 15-17. In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure using hindsight reconstruction.

In view of the above discussion, since we are of the opinion that the proposed combination of references set forth by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claims 1, 8, and 15-17, nor of claims 2, 4-6, 9, 11-13, and 18 dependent thereon.

#### *Claims 3 and 10*

We also do not sustain the obviousness rejection of dependent claims 3 and 10 in which the Examiner has applied the Evans reference to Spight and Clune to address the image targeting feature of rejected dependent claims 3 and 10. We find nothing in Evans, taken individually or collectively, which overcomes the innate deficiencies of the combination of Spight and Clune as discussed *supra*.

#### CONCLUSION OF LAW

Based on the analysis above, we conclude that the Examiner erred in rejecting claims 1-6, 8-13, and 15-18 for obviousness under 35 U.S.C. § 103(a).

Appeal 2009-010635  
Application 10/699,985

DECISION

The Examiner's 35 U.S.C. § 103(a) rejections of claims 1-6, 8-13, and 15-18, all of the appealed claims, are reversed.

REVERSED

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